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Paper 1
Declared: 20 February 2009

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,689 McK
Technology Center 1600

ANTHONY F. HADFIELD, SYED M. SHAH,
MICHAEL W. WINKELY, KAREN W. SUTHERLAND,
JAMES A. PROVOST, AERI PARK, REX A. SHIPPLETT,
BRENTON W. RUSSELL and BEAT T. WEBER

Patent 6,673,838 B2,
Junior Party,

v.

THOMAS P. JERUSSI and CHRISANTHA H. SENANAYAKE,

Application 11,091,518,
Senior Party.

Before: Fred E. McKelvey, *Senior Administrative Patent Judge.*

DECLARATION

1 Part A
2 Declaration of Interference
3

4 An interference is declared pursuant to 35 U.S.C. § 135(a).

5 Details of the application, patent, count and claims designated
6 as corresponding or as not corresponding to the count appear in
7 Parts E and F.

8
9 Part B
10 Designation to manage
11

12 Senior Administrative Patent Judge Fred E. McKelvey has been
13 designated to manage the interference. 37 CFR § 41.104(a).

14
15 Part C
16 Standing Order
17

18 A copy of a STANDING ORDER (3 Jan. 2006) (Paper 2)
19 accompanies this DECLARATION.

20 The STANDING ORDER applies to this contested case.

21 Part D
22 Initial Conference Call and Motions Lists
23

24 Conference Call

25 A conference call (together with a conference call in
26 Interference 105,685) to set dates for action in this contested case is
27 scheduled for:

28 2:00 p.m. (1400 hours Eastern Time) on 1 April 2009.

29 The Board will initiate the conference call.
30

1 Motions Lists

2 On or before:

3 Noon (1200 hours Eastern time) on 26 March 2009,
4 each party shall file, and on or before:

5 5:00 p.m. (1700 hours Eastern time) on 26 March 2009,
6 each party shall serve a notice stating the relief the party requests,
7 *i.e.*, a motions list including motions the party seeks authorization to
8 file. 37 CFR §§ 41.120(a) & 41.204; STANDING ORDER ¶¶ 104.2.1,
9 120 & 204.

10 The default procedure for filing and serving motions lists is that
11 motions lists are to be *filed* before being *served*.

12 By filing before service, one party will not have access to an
13 opponent's motions list prior to the filing of the party's motions list.

14 Nevertheless, the parties may mutually agree to discuss and
15 serve motions lists at any time prior to the date and time motions lists
16 are due.

17 The following shall be included in motions lists.

18 (1) Proposed motion for benefit (*i.e.*, to be accorded an
19 earlier constructive reduction to practice) must identify the
20 application(s) for which benefit will be sought.

21 (2) Proposed motion to attack benefit must identify the
22 application(s) to be attacked.

23 (3) Proposed motion seeking judgment against an
24 opponent based on alleged unpatentability must identify the statutory
25 basis for the alleged unpatentability and:

26 (a) if based on prior art, identify the prior art;

1 (b) if based on the first paragraph of 35 U.S.C.
2 § 112, (i) identify whether written description, enablement or best
3 mode will be the basis for the motion, and (ii) briefly identify the basis
4 for any alleged unpatentability;

5 (c) if based on an alleged failure to comply with
6 35 U.S.C. § 135(b), briefly identify the reason;

7 (d) if based on the second paragraph of 35
8 U.S.C. § 112, identify the limitation which is believed to be indefinite.

9 (4) Proposed motion based on no interference-in-fact
10 shall briefly identify the reason no interference-in-fact is believed to
11 exist.

12 (5) Proposed motion to designate additional claims as
13 corresponding to a count or as not corresponding to a count shall
14 identify the claims involved.

15 (6) Proposed motion to add or substitute a new count
16 shall explain why the added or substitute count is necessary.

17 A motions list shall not contain any "reservation clause"
18 whereby a party purports to reserve a right to file additional motions.
19 Additional motions are those authorized by the Board consistent with
20 the rules.

21 A sample schedule for taking action during the motions phase
22 of the interference appears as Form 2 (page 69) of the STANDING
23 ORDER.

24 Counsel are encouraged to discuss the schedule prior to the
25 conference and agree to on times for taking action generally
26 consistent with the sample schedule.

27 A typical motions phase last about eight (8) months.

- 1 The parties should be prepared at the conference to justify any
- 2 request for shorter or longer time periods.

3

1 Part E

2
3 Identification of the Parties
4 Assignment of Exhibit Numbers
5 Initiating Settlement Discussions
6

7 Junior Party

8
9 Inventors:

Anthony F. Hadfield, NY
Syed M. Shah, NJ
Michael W. Winkley, NY
Karen W. Sutherland, NY
James A. Provost, UK
Aeri Park, IN
Rex A. Shipplett, IN
Brenton W. Russell, IN
Beat T. Weber, CH

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19 Patent:

U.S. Patent, 6,673,838 B2
granted 6 January 2004
based on application 10/073,743,
filed 11 February 2002

20
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22
23
24 Title:

Succinate salt of O-desmethyl-venlafaxine

25
26 Real party in interest: Wyeth
27

Senior Party

Inventors:	Thomas P. Jerussi, MA Chrisantha H. Senanayake, MA
Application:	Application 11/091,518, filed 29 March 2005
Title:	O-desmethylvenlafaxine and methods of preparing and using the same
Real party in interest:	Sepracor Inc.

Assignment of Exhibit Numbers

Senior party: Exhibit Numbers 1001 through 1999.
Junior party: Exhibit Numbers 2001-2999.
Board: Exhibit Numbers 3001-3999.

Initiating Settlement Discussions

STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

The senior party is responsible for initiating settlement discussions required by the STANDING ORDER.

Part F
Count and Claims of the Parties

The composition of claims 23, 25 or 26 of Hadfield
or
the composition of claims 1 or 64 of Jerussi.

Hadfield claim 23 reads:

A pharmaceutical composition comprising O-desmethyl
venlafaxine succinate and a pharmaceutically acceptable
carrier or excipient.

Hadfield claim 25 reads:

A pharmaceutical dosage form comprising a
therapeutically effective amount of O-desmethyl
venlafaxine succinate and a pharmaceutically acceptable
carrier or excipient.

Hadfield claim 26 reads:

An oral dosage form comprising a therapeutically effective
amount of O-desmethyl venlafaxine succinate and a
pharmaceutically acceptable carrier or excipient.

Jerussi claim 1 reads:

A pharmaceutical composition which comprises (±)-O-
desmethylvenlafaxine succinate and a pharmaceutically
acceptable carrier or excipient, wherein (±)-O-desmethyl-
venlafaxine is present at an amount of about 50 mg.

Jerussi claim 64 reads:

A pharmaceutical composition which comprises (±)-O-
desmethylvenlafaxine succinate and a pharmaceutically

1 acceptable carrier or excipient, wherein (\pm)-O-desmethyl-
2 venlafaxine is present at an amount of about 100 mg.

3
4 The claims of the parties are:

5
6 Hadfield: 1-46

7
8 Jerussi: 1, 12 and 60-69

9
10 The claims that correspond to Count 1 are:

11
12 Hadfield: 23-34 and 46.

13
14 Jerussi: 1, 12 and 60-69

15
16 The claims that do not correspond to Count 1 are:

17
18 Hadfield: 1-22 and 35-45

19
20 Jerussi: None

1 The parties are accorded an earlier constructive reduction to
2 practice (*i.e.*, benefit for the purpose of priority) of the following
3 applications:

4 Hadfield: None

5

6 Jerussi: Application 10/720,134,
7 filed 25 November 2003
8 [involvement in Interference 105,685]

9

10 Application 09/527,422,
11 filed 17 March 2000

Part G
Heading to be Used on Papers

The following heading shall be used on all papers filed in this
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper ____
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

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Senior Party.

Title of Paper, *e.g.*, [Name of party] MOTION 1

Part H

1 Order Form for Requesting File Copies

2 When requesting file copies, a party shall use STANDING
3 ORDER Form 4 (page 71).

4 Use of form 4 will expedite processing of any request.

5 a party should attach to any request for file copies a photocopy
6 of Part E (for involved files) and Part F (for benefit files) of this
7 DECLARATION with a hand-drawn circle around the patent and
8 application files for which a copy of a file wrapper is requested.

9 The parties are advised that a single order for file copies may
10 be filled by the Office of Public Records at more than one time.

11 STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).

12

1 Part I
2 Required Paragraph of Affidavits and Declarations
3

4 The Board has experienced cases in which a witness has
5 belatedly advanced reasons why the witness would be unable to
6 appear for cross examination at a reasonable time and place in the
7 United States.

8 Consequently, to prevent surprise and hardship to the party
9 relying on the testimony of a witness, the following paragraph must
10 be included on the signature page of all affidavits (including
11 declarations) filed in this case. STANDING ORDER ¶ 157.2 (Paper
12 2, pages 52-53).

13
14 In signing this affidavit, I understand that the affidavit will
15 be filed as evidence in a contested case before the Board
16 of Patent Appeals and Interferences of the United States
17 Patent and Trademark Office. I also acknowledge that I
18 may be subject to cross examination in the case and that
19 cross examination will take place within the United States.
20 If cross examination is required of me, I will appear for
21 cross examination within the United States during the
22 time allotted for cross examination.

1 (via electronic mail):

2 Attorney for Jerussi
3 (real party in interest Sepracor Inc.):

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24 (real party in interest Wyeth):

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